APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/904,022	07/12/2001	Donald Henry Willis	PU010149	1946

7590 08/10/2006	EXAMINER

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EXAMINER
CHOWDHURY, NIGAR

ART UNIT	PAPER NUMBER
2621	

DATE MAILED: 08/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/904,022	WILLIS, DONALD HENRY
	Examiner	Art Unit	
	Nigar Chowdhury	2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*18 May 2006*</u>.

2a)☒ This action is **FINAL.**   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle,* 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-10* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *12 July 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   Applicant's arguments filed 05/18/2006 have been fully considered but they are not persuasive.

2.   In re pages 5-8, applicant argue that Boyce merely discloses that a method and apparatus for generating a fully intra-coded video frame from a received progressive refresh bitstream representing a series of inter-coded video frames. In the invention of Boyce, intra-coded macroblocks of received video frames are identified, selected, processed and stored to facilitate later combination into a single fully intra-coded composite video frame suitable for use during VTR trick play operation and Boyce fails to disclose, suggest or anticipate the invention of the applicant, at least with respect to independent claim 1, which specifically recites:

"A method of recording onto a storage medium a video segment comprising the steps of:

receiving said video segment, wherein said video segment contains at least one predictive picture containing intra macroblocks; and,

selectively converting said at least one predictive picture into an intra picture thereby replacing said at least one predictive picture with said intra picture in said video segment."

3.   In response, the examiner respectfully disagrees. Boyce discloses from Col. 6

line 33-49, that " Referring now to the drawings, and initially to Fig. 1, there is illustrated

a data extraction and frame forming ...., a frame forming circuit 18 and a video

frame selection circuit 20."

Boyce also discloses from Col. 7 line 1-11, that "The ||SP circuit 14 has an input

coupled to the output of .... single fully intra-coded frame."

4.   In re pages 8, 9, applicant discloses "single video segment" which limitation is not

in the claim.   The specification is not the measure of invention.   Therefore, the

limitations contained therein can not be read into the claims for the purpose of avoiding

the prior art. In re Sporck, 55 CCPA 743, 386 F.2d 924, 155 USPQ 687 (1968).

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6.   Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by US

Patent No. 5,726,711 by Boyce.

7.   Regarding claim 1, a method of recording onto a storage medium a video

segment (Fig. 1, Col. 6 lines 15-23) comprising the steps of:

- Receiving video segment, wherein video segment contains at least one predictive picture containing intra macroblocks (Fig. 1, Col. 6 lines 33-49)

- Selectively converting at least one predictive picture into an intra picture thereby replacing at least one predictive picture with intra picture in video segment (Fig. 1, Col. 7 line 1-11).

8.   Regarding claim 2, the method according to claim 1, video segment contains at least one introductory predictive picture and converting step further comprises the step of selectively decoding a predetermined number of introductory predictive pictures to obtain a properly decoded predictive picture (Fig. 3, Col. 12 lines 37-48).

9.   Regarding claim 3, the method according to claim 2, predetermined number is based in part on the amount of intra macroblocks in each introductory predictive pictures (Col. 10 lines 40-55).

10.   Regarding claim 4, the method according to claim 2, wherein video segment contains at least one subsequent predictive picture and converting step further comprises the steps of:

- Selectively decoding subsequent predictive pictures (Fig. 3, Col. 12 lines 38-49)

- Selectively re-encoding into intra pictures predictive pictures selected from the group comprising subsequent predictive pictures or introductory predictive pictures (Fig. 3, Col. 15 lines 6-15).

11.   Regarding claim 5, the method according to claim 1, wherein video segment is an MPEG video segment that does not contain any intra pictures (Col. 5 lines 55-67).

12.   System claims 6-10 are rejected for the same reasons as discussed in method claims 1-5 above.

Conclusion

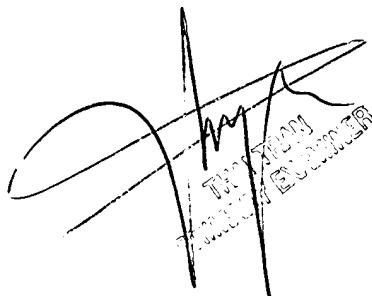**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nigar Chowdhury whose telephone number is 571-272-8890. The examiner can normally be reached on 9 AM - 5 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

NC
08/06/2006